

Remarks:

Claims 1-69 remain for consideration in this application. Claims 1 and 28 have been amended.

Turning now to the March 12, 2003, office action, from the parent application (Serial No. 09/836,832), it is noted with appreciation that the Examiner withdrew all rejections from the previous office action.

The Examiner did, however, raise two new prior art rejections. These rejections can be summarized as follows:

- (1) claims 2-5, 8-9, 11-16, 19-20, 22-28, 30-34, 36-42, 44-51, 53-54, 56-58, 60-62, and 64-71 were rejected under 35 U.S.C. § 102(e) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being obvious in view of, U.S. Patent No. 6,207,787 to Fahey et al. (hereinafter "the Fahey et al. patent"); and
- (2) claims 52, 55, 59, 63, and 71 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the Fahey et al. patent.

At the time of the March 12, 2003, office action, claims 11, 12, 24, 36, 37, 46, 51, 56, 60, 64, 66, and 68 were in independent format. Rejection (2) was only raised against dependent claims. Thus, if the rejection set forth in rejection (1) is overcome, then the rejection set forth in rejection (2) will necessarily be overcome. As a result, Applicants have focused their arguments on the patentability of the independent claims over the Fahey et al. patent as set forth under rejection (1) above.

With the filing of the present continuation application, the claim numbering was changed somewhat. The presently pending independent claims are claims 1, 11, 23, 28, 35, 44, 49, 54, 58, 62, 64, and 66. Each of these independent claims includes the following recitations:

- the composition has a spin bowl compatibility test result of greater than about 90% when propylene glycol methyl ethyl is used - claims 1, 28, and 49;
- the composition has a weight ratio of strong acid to weak acid of from about 0:100 to about 50:50 - claims 11, 35, and 54;
- the composition includes a compound selected from the group consisting of bisphenol A and α -cyano-4-hydroxycinnamic acid - claims 23, 44, and 58; and
- from about 0.02-5% by weight of a weak acid - claims 62, 64, and 66.

Each of the above limitations is entirely missing from the Fahey et al. patent, and this will be explained on a limitation-by-limitation basis.

Independent claims 1, 28, and 49 recite that the compositions give a spin bowl compatibility test result of greater than about 90%. The Examiner has asserted that this limitation is inherently present in the Fahey et al. composition. The Applicants are submitting herewith a declaration by Xie Shao, one of the inventors named in the present application. In this declaration, Ms. Shao describes how two compositions prepared according to the Fahey et al. patent were duplicated. The Fahey et al. patent did not contain any specific or detailed examples to follow, so the Applicants' attorney consulted with the Examiner during a phone conference on April 15, 2003. During that conference, the Examiner indicated that a co-polymer of benzophenone and bisphenol A should be included in the composition as this is the polymer disclosed in column 6, lines 21 et seq. Furthermore, the

Examiner indicated that the other ingredients present in the composition should be selected from items (1)-(4) found in column 5, lines 51-55, except that each of the ingredients should be included (i.e., the lower limit of 0% by weight should be ignored). The Shao declaration sets forth the ingredients and percentages by weight of those ingredients in the two compositions tested. The spin bowl compatibility was determined. Claims 1, 28, and 49 have been amended to recite that the spin bowl compatibility is at least about 90% when propylene glycol methyl ether is the solvent. Neither of tested compositions possessed this property as shown in the Shao declaration. Again, this limitation represents a significant improvement over the art in that the blocking of drain pipes and buildup in spin bowls is inhibited or avoided entirely. Any rejection to claims 1, 28, and 49 in light of the Fahey et al. patent should be withdrawn.

Independent claims 11, 35, and 54 (formerly 12, 37, and 56, respectively) recite that the weight ratio of strong acid to weak acid is from about 0:100 to about 50:50. Claims 62, 64, and 66 recite that the composition comprises from about 0.02-5% by weight of a weak acid. The Examiner maintained rejections against these claims as being anticipated by (or obvious in view of) the Fahey et al. patent. However, the Applicants again submit that this rejection is inappropriate. The recited range of strong acid to weak acid of from about 0:100 to about 50:50 *requires* the presence of a weak acid as does the limitation of from about 0.02-5% by weight of a weak acid. If the Applicants understand the rejection, the Examiner is taking the position that the use of bisphenol A (column 3, lines 6 et seq.; column 5, lines 2 et seq.) by the Fahey et al. patent supplies the weak acid because bisphenol A is disclosed by the Applicants as a weak acid. However, Fahey et al. teach the use of bisphenol A to make a copolymer. The polymerized bisphenol A is subsequently used as part of a

coating composition. The polymerized bisphenol A is *not* capable of acting as a weak acid. This is confirmed by examining the structures disclosed by Fahey et al. in column 4, lines 28 et seq. as well as in the Fahey et al. claims. This structure no longer contains any -OH groups and is, therefore, not acidic. Thus, it is submitted that claims 11, 35, 54, 62, 64, and 66 are patentable over the Fahey et al. patent.

Claims 23, 44, and 58 (which recite that the composition includes a compound selected from the group consisting of bisphenol A and α -cyano-4-hydroxycinnamic acid) are patentable over the Fahey et al. patent for reasons similar to the reasons for patentability of claims 11, 35, 54, 62, 64, and 66. That is, there is no teaching of bisphenol A being present as a compound in the Fahey et al. composition. Rather, bisphenol A is present as part of a polymer, and there is no teaching or suggestion to use bisphenol A in any way other than as a monomer in a polymer.

In view of the foregoing, a Notice of Allowance appears to be in order and such is respectfully requested. Any additional fee which is due in connection with this amendment should be applied against Deposit Account No. 19-0522.

Respectfully submitted,

By 

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